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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN FRED DAVIS, KEVIN DAVID HIMBERGER,
CLARK DEBS JEFFRIES, and GARRETH JOSEPH JEREMIAH

Appeal 2010-000189
Application 10/796,161¹
Technology Center 2400

Before JOHN A. JEFFERY, ST. JOHN COURtenay III, and
JAMES R. HUGHES, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal from the Examiner's rejection of claims 1-16 and 21-28. Claims 17-20 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Application filed March 9, 2004. The real party in interest is International Business Machines Corp. (Br. 1.)

We affirm.

Appellants' Invention

The invention at issue on appeal concerns a system, program product, and method for blocking unwanted electronic mail (e-mail) messages.
(Spec. 3:3-17; Abstract.)²

Representative Claim

Independent claim 1, reproduced below with the key disputed limitations emphasized, further illustrates the invention:

1. A method of blocking unwanted e-mails, said method comprising the steps of:

determining that an e-mail is unwanted;

determining a source IP address of said unwanted e-mail; and

determining a registrant of said source IP address of said unwanted e-mail and querying an entity that manages registration of IP addresses to determine other source IP addresses registered to said registrant of the source IP address of said unwanted e-mail, and in response, blocking subsequent e-mails from said other IP addresses.

Rejection on Appeal

The Examiner rejects claims 1-16 and 21-28 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent Pub. No. 2004/0177120 AI published Sep. 9, 2004 (filed Mar. 7, 2003) (“Kirsch”) and

² We refer to Appellants’ Specification (“Spec.”) and Appeal Brief (“Br.”) filed March 23, 2009. We also refer to the Examiner’s Answer (“Ans.”) mailed June 25, 2009. Appellants’ originally filed Specification does not include line numbers – we begin our numbering at the first word at the top of each page.

The Spamhaus Project – The Spamhaus Block List (“SBL”), available at <http://web.archive.org/web/20011211165406/http://www.spamhaus.org/sbl/> 6/12/2008 (“Spamhaus”).

ISSUE

Based on our review of the administrative record, Appellants’ contentions, and the Examiner’s findings and conclusions, the pivotal issue before us follows:

Does the Examiner err in concluding that Kirsch in combination with Spamhaus would have collectively taught or fairly suggested: (1) “determining a source IP address of said unwanted e-mail;” (2) “determining a registrant of said source IP address . . . and querying an entity that manages registration of IP addresses to determine other source IP addresses registered to said registrant;” and (3) “in response, blocking subsequent e-mails from said other IP addresses” as recited in claim 1?

FINDINGS OF FACT

We adopt the Examiner’s findings in the Answer and Final Office Action as our own, except as to those findings that we expressly overturn or set aside in the Analysis that follows. We also find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Appellants' Claim & Specification

1. Appellants' claim 1 recites, in relevant part, "querying an entity that manages registration of IP addresses to determine other source IP addresses registered to said registrant." (Br. 13, claim 1.) Appellants explain that: "The range finder program 130 is also coupled by a network to an existing/known Internet service company called 'Internet Assigned Number Authority' company or 'IANA' 138 (or a *similar Internet service*)" (Spec. 8:7-9 (emphasis added); *see Br. 2 (citing same)*). Appellants do not explicitly define "an entity that manages registration of IP addresses to determine other source IP addresses registered to said registrant" (claim 1) either in the claim or in their Specification.

ANALYSIS

Appellants argue independent claim 1 together with independent claims 9 (see below) and 21 and dependent claims 2, 4-7, 10, 12-16, 22, and 24-28 as a group based on claim 1. (Br. 3-12.) Appellants also provide additional nominal arguments with respect to dependent claim 3 (Br. 8), dependent claim 8 (Br. 9), independent claim 9 (Br. 9-11), dependent claim 11 (Br. 11), and dependent claim 23 (Br. 12). We find, however, these nominal arguments simply restate the claim language or reiterate the arguments made with respect to claim 1. Therefore, we select claim 1 as representative of Appellants' arguments and groupings. 37 C.F.R. § 41.37(c)(1)(vii). *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) ("[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief"); *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987). We consider only those arguments that

Appellants have actually raised in their Brief. Arguments that Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants have the opportunity on appeal to the BPAI to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). The Examiner sets forth a detailed explanation of the obviousness rejection in the Examiner's Answer with respect to each of the claims (Ans. 4-10) and, in particular, claim 1 (*id.* at 4-5, 8-9). Therefore, we look to the Appellants' Brief to show error in the proffered findings and conclusions. *See Kahn*, 441 F.3d at 985-86.

Claim 1

The Examiner rejects Appellants' independent claim 1 as being obvious over the combination of Kirsch and Spamhaus. (Ans. 4-5, 8-9.) Specifically, the Examiner finds that Kirsh teaches filtering electronic mail messages (e-mail) (determining that an e-mail is unwanted), determining a source IP address of the unwanted e-mail, and blocking unwanted e-mail messages. (Ans. 4-5, 8-9 (citing Kirsch, ¶¶ [0025] and [0036]; Fig. 3).) The Examiner further finds that Spamhaus teaches determining a registrant of the determined source IP address and querying a website/service (an entity that manages registration of IP addresses) to determine other source IP addresses registered to the registrant of the source IP address.

Appellants contend that:

[i]n contrast to present claim 1, Kirsch . . . does not teach that a *registrant* of the source IP address of the unwanted e-mail is determined, and an entity that manages registration of IP addresses is queried to determine other source IP addresses

registered to the registrant of the source IP address of the unwanted e-mail, and in response, subsequent e-mails from the other IP addresses are blocked.

(Br. 5.) Appellants further contend that:

Spamhaus states that individual IP addresses of spammers are identified and put in a list, but there is no teaching of the feature of claim 1 where a registrant of the source IP address of the unwanted e-mail is determined, and an entity that manages registration of IP addresses is queried to determine other source IP addresses registered to the registrant of the source IP address of the unwanted e-mail, and in response, subsequent e-mails from the other IP addresses are blocked.

(Br. 6; *see id.* at 7-8.) In summary, Appellants assert that “[n]either Kirsch nor Spamhaus teach or suggest the steps of identifying the registrant of an e-mail and then using the registrant information to identify from a registration management entity other IP addresses registered to the same registrant (and blocking them as well).” (Br. 7-8).

Upon consideration of the evidence on this record and each of Appellants’ contentions, we find that the preponderance of evidence on this record supports the Examiner’s conclusion that the subject matter of Appellants claim 1 is unpatentable over the combination of Kirsch and Spamhaus. Accordingly, we sustain the Examiner’s rejection of claim 1 for the reasons set forth in the Answer, which we incorporate herein by reference. (Ans. 4-5, 8-9.)

As explained by the Examiner, Kirsch describes determining a source IP address of the unwanted e-mail and filtering the unwanted e-mail. (Ans. 4-5, 8-9 (citing Kirsch, ¶¶ [0025] and [0036].) As further explained by the Examiner, Spamhaus describes a website or web service listing the IP addresses of known spammers as well as the name of the company that owns

the IP addresses (the registrant). (Ans. 4-5, 8-9.) We agree with the Examiner that the combination of Kirsch and Spamhaus teaches each feature of Appellants' claim.

Appellants appear to assert that Spamhaus does not teach or suggest "an entity that manages registration of IP addresses to determine other source IP addresses registered to said registrant" (claim 1). We disagree. Appellants do not explicitly define "an entity that manages registration of IP addresses to determine other source IP addresses registered to said registrant" either in the claim or in their Specification. (FF 1.) Appellants do, however, explain that such an entity may be an "existing/known Internet service company" such as the "Internet Assigned Number Authority" or "a *similar Internet service.*" (FF 1.) In view of Appellants' disclosure, we broadly but reasonably construe such an entity to be an Internet web site or service that performs the claimed functionality of allowing one to determine IP addresses registered to a registrant or vice versa. Thus, we view Spamhaus as broadly teaching or at least suggesting such an entity. Accordingly, we conclude, as did the Examiner, that the combination of Kirsch and Spamhaus would have taught or fairly suggested the disputed features of representative claim 1.

We find Appellants' contrary arguments unpersuasive of error in the Examiner's rejection for the reasons explained above. Further, we note that Appellants attempt to attack the references individually, instead of addressing the combination of references. (Br. 5-7.) *See In re Merck & Co.,* 800 F.2d 1091, 1097 (Fed. Cir. 1986) (noting that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references) (citing *In re Keller*, 642 F.2d 413, 425

(CCPA 1981)). Further still, Appellants failed to file a Reply Brief to rebut the findings and responsive arguments made by the Examiner in the Answer. It follows that Appellants do not persuade us of error in the Examiner's obviousness rejection of representative claim 1. Appellants also do not persuade us of error in the Examiner's obviousness rejection of independent claims 9 and 21 and dependent claims 2-8, 10-16, and 22-28 not separately argued with particularity (*supra*). Accordingly, we affirm the Examiner's obviousness rejection of claims 1-16 and 21-28.

CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 1-16 and 21-28 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's rejection of claims 1-16 and 21-28 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED